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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
09/921,654	08/03/2001	Anshul Amar	AHC-001	5834

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PROSKAUER ROSE LLP  
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EXAMINER

PASS, NATALIE

ART UNIT	PAPER NUMBER
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3626

SHORTENED STATUTORY PERIOD OF RESPONSE	MAIL DATE	DELIVERY MODE
3 MONTHS	01/25/2007	PAPER

**Please find below and/or attached an Office communication concerning this application or proceeding.**

If NO period for reply is specified above, the maximum statutory period will apply and will expire 6 MONTHS from the mailing date of this communication.

## Office Action Summary

Application No.

09/921,654

Applicant(s)

AMAR ET AL.

Examiner

Natalie A. Pass

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-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

### Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) OR THIRTY (30) DAYS, WHICHEVER IS LONGER, FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

### Status

- 1) ☒ Responsive to communication(s) filed on 18/5/06, 14/8/06, 9/11/06.
- 2a) ☒ This action is **FINAL**. 2b) ☐ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

### Disposition of Claims

- 4) ☒ Claim(s) 1-20, 24-28 and 30-33 is/are pending in the application.
- 4a) Of the above claim(s) \_\_\_\_\_ is/are withdrawn from consideration.
- 5) ☐ Claim(s) \_\_\_\_\_ is/are allowed.
- 6) ☒ Claim(s) 1-20, 24-28 and 30-33 is/are rejected.
- 7) ☐ Claim(s) \_\_\_\_\_ is/are objected to.
- 8) ☐ Claim(s) \_\_\_\_\_ are subject to restriction and/or election requirement.

### Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on \_\_\_\_\_ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.  
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).  
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

### Priority under 35 U.S.C. § 119

- 12) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☐ All b) ☐ Some \* c) ☐ None of:
- ☐ Certified copies of the priority documents have been received.
  - ☐ Certified copies of the priority documents have been received in Application No. \_\_\_\_\_.
  - ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

\* See the attached detailed Office action for a list of the certified copies not received.

### Attachment(s)

- ☐ Notice of References Cited (PTO-892)
- ☐ Notice of Draftsperson's Patent Drawing Review (PTO-948)
- ☒ Information Disclosure Statement(s) (PTO/SB/08)  
Paper No(s)/Mail Date 2 Nov./06 & 18 May /06.
- ☐ Interview Summary (PTO-413)  
Paper No(s)/Mail Date. \_\_\_\_\_.
- ☐ Notice of Informal Patent Application
- ☐ Other: \_\_\_\_\_.

## **DETAILED ACTION**

### ***Notice to Applicant***

1. This communication is in response to the responses filed 18 May 2006, 14 August 2006, and 9 November 2006. Claims 1-3, 9, 12-13, 15, 18, 20, 25, 27-28, and 30-33 have been amended. Claims 21-23 and 29 have been canceled. Claims 1-20, 24-28, 30-33 remain pending. The Information disclosure statements filed 18 May 2006 and 2 November 2006 have been entered and considered.

### ***Claim Rejections - 35 USC § 112***

2. The following is a quotation of the first paragraph of 35 U.S.C. 112:

The specification shall contain a written description of the invention, and of the manner and process of making and using it, in such full, clear, concise, and exact terms as to enable any person skilled in the art to which it pertains, or with which it is most nearly connected, to make and use the same and shall set forth the best mode contemplated by the inventor of carrying out his invention.

3. Newly added claim 24 is rejected under 35 U.S.C. 112, first paragraph, as containing subject matter which was not described in the specification in such a way as to reasonably convey to one skilled in the relevant art that the inventor(s), at the time the application was filed, had possession of the claimed invention.

(A) Claim 24 recites limitations that are new matter, and are therefore rejected. The added material which is not supported by the original disclosure is as follows:

- "an association," as disclosed in claim 24 at line 2.

35 U.S.C. 132 states that no amendment shall introduce new matter into the disclosure of the invention. "New matter" constitutes any material which meets the following criteria:

a) It is added to the disclosure (either the specification, the claims, or the drawings) after the filing date of the application, and

b) It contains new information which is neither included nor implied in the original version of the disclosure. This includes the addition of physical properties, new uses, etc.

In particular, the Examiner was unable to find any support for this newly added language within the specification as originally filed on 3 August 2001. Applicant is respectfully requested to clarify the above issues and to specifically point out support for the newly added limitations in the originally filed specification and claims.

Applicant is required to cancel the new matter in the reply to this Office Action.

4. If Applicant continues to prosecute the application, revision of the specification and claims to present the application in proper form is required. While an application can, be amended to make it clearly understandable, no subject matter can be added that was not disclosed in the application as originally filed on 3 August 2001.

5. The rejection of claim 9 is under 35 U.S.C. 112, second paragraph for being indefinite is hereby withdrawn due to the amendments filed 18 May 2006, 14 August 2006, and 9 November 2006.

***Claim Rejections - 35 USC § 103***

6. The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

7. Claims 1-8, 13-20, 24-28, 30-33 are rejected under 35 U.S.C. 103(a) as being unpatentable over Burks et al., U.S. Patent Number 6, 453, 297 for substantially the same reasons given in the previous Office Action (paper number 12302005), and further in view of and further in view of Campbell et al., U.S. Patent Number 6, 047, 259. Further reasons appear hereinbelow.

(A) As per claim 1, Burks teaches a method for managing a medical practice comprising:

(a) communicating with a medical practice client user interface over a first communication network (Burks; column 3, lines 9-15);

(b) communicating with a payor server over a second communications network (Burks; column 3, lines 33-36);

(c) receiving information associated with an event related to a patient from at least one of the medical practice client user interface or the payor server (Burks; column 6, lines 8-19); and

(g) using at least a portion of the information associated with the event to create an insurance claim following completion of the one or more tasks (Burks; column 6, lines 19-24).

Although Burks teaches performing one or more tasks associated with the event (Burks; column 6, lines 15-19), and automatically and repeatedly interacting with the information associated with the event by applying one or more rules within a set of rules and performing transactions with the “trading partner” (reads on “payor”) server (Burks; column 3, line 60 to column 4, line 6), Burks fails to explicitly disclose

(d) performing by a medical practice management server one or more workflow tasks in a patient workflow associated with the event;

(e) performing, by a medical practice management server, one or more workflow tasks in a billing workflow associated with the event; and

(f) automatically and repeatedly interacting with the information associated with the event during the patient workflow tasks and billing workflow tasks.

However, the above features are well-known in the art, as evidenced by Campbell.

In particular, Campbell teaches

(d) performing by a medical practice management server (Campbell; Figure 2, Item 202) one or more workflow tasks in a patient workflow associated with the event (Campbell; column 3, lines 54-59, column 5, lines 32-37, 61-66, column 6, lines 22-45);

(e) performing, by a medical practice management server (Campbell; Figure 2, Item 202, column 5, lines 32-37, 61-66, column 6, lines 22-45), one or more workflow tasks in a billing workflow associated with the event (Campbell; column 7, lines 9-15); and

(f) automatically and repeatedly interacting with the information associated with the event during the patient workflow tasks and billing workflow tasks (Campbell; column 2, lines 31-37, column 15, lines 48-51, column 18, lines 10-11, 27-43).

It would have been obvious to one of ordinary skill in the art at the time the invention was made to modify the method of Burks to include these limitations, as taught by Campbell, with the motivations of providing a graphical and interactive medical office management system that effectively manages workflow, automatically generates client education information, tracks the conducting of a physical examination, diagnosing of medical conditions and management of a therapy protocol, and tracks the flow of patients in a medical office (Campbell; Abstract, column 1, lines 35-37).

(B) The amendments to claims 2-3, 5, 13, 14, 18 appear to have been made merely to correct minor typographical or grammatical errors. While these changes render the language of the claim smoother and more consistent, they otherwise affect neither the scope and breadth of the claim as originally presented nor the manner in which the claim was interpreted by the Examiner when applying prior art within the previous Office Action.

As such, the recited claimed features are rejected for the same reasons given in the prior Office Action (paper number 12302005, section 5, page 4), and incorporated herein.

(C) Claims 4, 6-8, 16-17, 19 have not been amended and are rejected for the same reasons given in the previous Office Action (paper number 12302005, section 5, pages 4-6), and incorporated herein.

(D) Amended claim 15 differs from amended method claim 1, in that it is a system rather than a method for managing a medical practice.

System claim 15 repeats the subject matter of claim 1, respectively, as a set of elements rather than a series of steps. As the underlying processes of claim 1 have been shown to be fully

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disclosed by the teachings of Burks and Campbell in the above rejection of claim 1, it is readily apparent that the system disclosed by Burks and Campbell includes the apparatus to perform these functions. As such, these limitations are rejected for the same reasons given above for method claim 1, and incorporated herein.

(E) Amended claim 20 differs from amended method claim 1, in that it is a system rather than a method for medical practice management.

System claim 20 repeats the subject matter of claim 1, respectively, as a set of “means-plus-function” elements rather than a series of steps. As the underlying processes of claim 1 have been shown to be fully disclosed by the teachings of Burks and Campbell in the above rejection of claim 1, it is readily apparent that the system disclosed by Burks and Campbell includes the apparatus to perform these functions. As such, these limitations are rejected for the same reasons given above for method claim 1, and incorporated herein.

(F) As per newly added claims 24-26, Burks and Campbell teach a method as analyzed and discussed in claim 1 above,

wherein a portion of the information associated with the event comprises an association between a first procedure and a second procedure (Campbell; column 17, lines 55-56).

wherein the performing of the workflow tasks in the billing workflow following the event further comprise the steps of “setting a flag” (reads on “moving the claim into a claim inquiry group and assigning an additional task to be completed to close the claim” (Burks; Figure 9, column 9, lines 45-60, column 12, lines 55-57));



wherein the one or more rules in the set of rules have universal applicability, apply only to one or more specific insurance packages, apply only to specific medical care providers, or any combination thereof (Burks; column 3, line 45 to column 4, line 6, column 5, line 66 to column 6, line 19).

The motivations for combining the respective teachings of Burks and Campbell are as given in the rejection of claim 1 above, and incorporated herein.

(G) As per newly added claim 27, Burks and Campbell teach a method for managing a medical practice comprising:

(a) communicating with a medical practice client user interface over a first communication network (Burks; column 3, lines 9-15);

(b) communicating with a payor server over a second communications network (Burks; column 3, lines 33-36);

(c) receiving information associated with an event related to a patient from at least one of the medical practice client user interface or the payor server, or any combination thereof (Burks; column 6, lines 8-19); and

(d) performing one or more workflow tasks in a patient workflow associated with the event (Campbell; column 3, lines 54-59, column 5, lines 32-37, 61-66, column 6, lines 22-45);

(e) performing one or more workflow tasks in a billing workflow associated with the event (Campbell; column 7, lines 9-15);

(f) after performance of the one or more workflow tasks in the patient workflow and the one or more workflow tasks in the billing workflow, storing at least a portion of the information

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associated with the event for a purpose other than to create an insurance claim (Campbell; column 10, lines 47-62);

(g) automatically and repeatedly interacting with the information associated with the event in connection with the performed patient workflow and billing workflow tasks by applying one or more rules in a set of rules (Campbell; column 2, lines 31-37, column 15, lines 48-51, column 18, lines 10-11, 27-43).

The motivations for combining the respective teachings of Burks and Campbell are as given in the rejection of claim 1 above, and incorporated herein.

(H) Claims 28, 30-33 differ from method claims 1-5 by reciting a “computer program product, tangibly embodied...” in the preamble. As per this limitation, Burks clearly discloses his invention to be implemented on a computer program product (Burks; column 3, lines 9-32). The remainder of claims 28, 30-33 repeat the limitations of claim 1-5, and are therefore rejected for the same reasons given above for claims 1-5.

The motivations for combining the respective teachings of Burks and Campbell are as given in the rejection of claim 1 above, and incorporated herein.

8. Claims 9-11 are rejected under 35 U.S.C. 103(a) as being unpatentable over Burks et al., U.S. Patent Number 6, 453, 297 and Campbell et al., U.S. Patent Number 6, 047, 259, as applied to claims 1 and 2 above, and further in view of Berman et al., U.S. Patent Number 5, 995, 939 for substantially the same reasons given in the previous Office Action (paper number 12302005). Further reasons appear hereinbelow.

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(A) The amendments to claim 9 appear to have been made merely to correct minor typographical or grammatical errors and to correct rejections under 35 USC § 112. While these changes render the language of the claim smoother and more consistent, they otherwise affect neither the scope and breadth of the claim as originally presented nor the manner in which the claim was interpreted by the Examiner when applying prior art within the previous Office Action.

As such, the recited claimed features are rejected for the same reasons given in the prior Office Action (paper number 12302005, section 7, pages 7-8), and incorporated herein.

(B) Claims 10-11 have not been amended and are rejected for the same reasons given in the previous Office Action (paper number 12302005, section 7, page 8), and incorporated herein.

9. Claim 12 is rejected under 35 U.S.C. 103(a) as being unpatentable over Burks et al., U.S. Patent Number 6, 453, 297 and Campbell et al., U.S. Patent Number 6, 047, 259, as applied to claims 1 and 2 above, and further in view of Ilsen et al., U.S. Patent Number 6, 757, 898 for substantially the same reasons given in the previous Office Action (paper number 12302005). Further reasons appear hereinbelow.

(A) The amendments to claim 12 appear to have been made merely to correct minor typographical or grammatical errors. While these changes render the language of the claim smoother and more consistent, they otherwise affect neither the scope and breadth of the claim as originally presented nor the manner in which the claim was interpreted by the Examiner when applying prior art within the previous Office Action.

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As such, the recited claimed features are rejected for the same reasons given in the prior Office Action (paper number 12302005, section 8, pages 9), and incorporated herein.

***Response to Arguments***

10. Applicant's arguments, filed 18 May 2006, with respect to claims 1-20, 24-27 have been considered but are moot in view of the new ground(s) of rejection.

***Conclusion***

11. Applicant's amendment necessitated the new ground(s) of rejection presented in this Office action. Accordingly, **THIS ACTION IS MADE FINAL**. See MPEP § 706.07(a).

Applicant is reminded of the extension of time policy as set forth in 37 CFR 1.136(a).

A shortened statutory period for reply to this final action is set to expire THREE MONTHS from the mailing date of this action. In the event a first reply is filed within TWO MONTHS of the mailing date of this final action and the advisory action is not mailed until after the end of the THREE-MONTH shortened statutory period, then the shortened statutory period will expire on the date the advisory action is mailed, and any extension fee pursuant to 37 CFR 1.136(a) will be calculated from the mailing date of the advisory action. In no event, however, will the statutory period for reply expire later than SIX MONTHS from the date of this final action.

12. Any response to this action should be mailed to:

**Commissioner of Patents and Trademarks  
Washington D.C. 20231**

or faxed to: **(571) 273-8300.**


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For informal or draft communications, please label "PROPOSED" or "DRAFT" on the front page of the communication and do NOT sign the communication. After Final communications should be labeled "Box AF."


13. Any inquiry concerning this communication or earlier communications from the examiner should be directed to Natalie A. Pass whose telephone number is (571) 272-6774. The examiner can normally be reached on Monday through Thursday from 9:00 AM to 6:30 PM. The examiner can also be reached on alternate Fridays.

14. If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Joseph Thomas, can be reached at (571) 272-6776. Any inquiry of a general nature or relating to the status of this application or proceeding should be directed to the Receptionist whose telephone number is (571) 272-3600.

15. Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free).

  
Natalie A. Pass

January 20, 2007

  
C. LUKE GILLIGAN  
PRIMARY EXAMINER  
TECHNOLOGY CENTER 3600